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Application no. 10/823,098

October 10, 2006

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Attn: Art Unit 2627 - Examiner Renner, Craig A

FROM: Stephen B. Ackerman, Reg. No. 37,761
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SUBJECT: Serial #: 10/823,098
File Date: 04/13/2004
Inventor: Kowang Liu
Examiner: Renner, Craig A
Art Unit: 2627
Title: Heat Extractor for Magnetic Reader-Writer

RESPONSE TO RESTRICTION REQUIREMENT

Dear Sir:

This is in response to the Restriction Requirement in the Office Action dated Sept. 8, 2006. In that office action, restriction was required to one of the following Inventions under

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner of Patents P.O. Box 1450, Alexandria, VA 22313-1450 on Oct. 10, 2006.

Signature 
Stephen B. Ackerman, Reg. No. 37,761

Date: Oct. 10, 2006

35 U.S.C. 121:

The inventions stated are:

I - Claims 1-6 and 25-29, drawn to a heat extractor, classified in class 165, subclass 185, and

II - Claims 7-24, drawn to a process to manufacture a magnetic write head, classified in class 29, subclass 603.07, and

III - Claims 30-39, drawn to a magnetic read-write head, classified in class 360, subclass 126.

Applicant provisionally elects to be examined the Invention described by the Examiner as Group I - Claims 1-6 and 25-29, drawn to a heat extractor classified in Class 165, subclass 185. This election is made with traverse of the requirement under 37 C.F.R. 1.143 for the reasons given in the following paragraphs.

The Examiner is respectfully requested to reconsider the Requirement for Restriction in the Office Action.

The Examiner gives the reasons for the distinctness between Inventions I and II as (1) that the process as claimed can be used to make other and materially different

product, or (2) the product as claimed can be made by another and materially different process (M.P.E.P. 806.05(f)). However, upon reading the process Claims against the product Claims one can readily see that the process Claims are directed to a method "to manufacture a magnetic write head", and that the product claims are directed to "a heat extractor" and "a method to dissipate heat", and that it is necessary to obtain claims in both the process and product claim language. The process claims necessarily use the product and vice versa. The field of search must necessarily cover both the process class/subclass 29/603.07 and product class/subclass 165/185, in addition to other related classes and subclasses, to provide a complete and adequate search. The fields of search for Groups I and II are clearly and necessarily co-extensive. The Examiner's suggestion that "the product as claimed can be made by another and materially different process, such as a process not including 'planarizing', for instance" is speculative and has nothing to do with the Claims as presented in this patent application.

The Examiner gives the reasons for the distinctness between Inventions II and III as (1) that the process as claimed can be used to make other and materially different product, or (2) the product as claimed can be made by another and materially different process (M.P.E.P. 806.05(f)). However, upon reading the process Claims against the product Claims one can readily see that the process Claims are directed to a method "to manufacture a magnetic write head", and that the product claims are directed to "a magnetic read-write head", and that it is necessary to obtain claims in both the process and product claim language. The process claims necessarily use the product and vice versa. The field of search must necessarily cover both the process class/subclass

29/603.07 and product class/subclass 360/126, in addition to other related classes and subclasses, to provide a complete and adequate search. The fields of search for Groups II and III are clearly and necessarily co-extensive. The Examiner's suggestion that "the product as claimed can be made by another and materially different process, such as a process not including 'planarizing', for instance" is speculative and has nothing to do with the Claims as presented in this patent application.

The Examiner states that Inventions III and I are related as combination and subcombination, and gives as the reasons for distinctness that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations. (M.P.E.P. ¹ 806.05(c)). However, upon reading the Invention III Claims against the Claims of Invention I, it can be seen that Invention III is drawn to a magnetic read-write head, while Invention I is drawn to "a heat extractor" and "a method to dissipate heat". As such, the field of search must necessarily cover both the Group I class/subclass 165/185 and the Group II class/subclass 360/126, in addition to other related Classes and subclasses to provide a complete and adequate search. The fields of search for the Group I and Group II inventions are clearly and necessarily co-extensive. The Examiner's suggestion that "the combination as claimed does not require the particulars of the subcombination as claimed because the combination as claimed does not require 'said conductive pedestal [having] a thermal conductivity between about 100 and 400 W/M.K, for instance" and "the subcombination has separate utility such as usable in a magnetic write head that does not

include a magnetic read head, for instance" is speculative and has little to do with the Claims as presented in this patent application.

Further, it is respectfully suggested that these reasons are insufficient to place the cost of added patent applications upon the applicants. Therefore, it is respectfully requested that the Examiner withdraw this restriction requirement for these reasons.

Withdrawal of the Restriction Requirement, and allowance of the present Patent Application, is respectfully requested.

It is requested that should there be any problems with this response, please call the undersigned Attorney at (845) 452-5863.

Respectfully submitted,

A handwritten signature in black ink, appearing to be 'SBA', written over the printed name.

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